



Atty. Dkt. No. 084437-0173

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Kazuhiro OHKOUCHI et al.

Title: PROCESS FOR PRODUCING  
COATED PREPARATION

Appl. No.: 10/542,997

International 1/28/2004

Filing Date:

371(c) Date: 07/21/05

Patent No.: 7,976,853

Grant Date: 7/12/2011

Examiner: Bethany P. BARHAM

Art Unit: 1615

Conf. No.: 7856

**REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT FOR  
PATENT UNDER 37 C.F.R. §1.705(d)**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants have calculated PTA for the captioned patent and have determined that the patent is entitled to 1012 days of Patent Term Adjustment, as shown on the attached sheet, which shows the relevant delays under 37 CFR §§1.702, 1.703 and 1.704:

(a) Total PTO delay: 1255 days

(b) Total Applicant delay: 243 days

Final PTA Determination under 37 CFR §1.703(f): 1012 days

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In accordance with 1.705(b)(2)(ii), the relevant dates as specified in §§1.703(a) through (e) for which an adjustment is sought and the adjustment as specified in § 1.703(f) to which the patent is entitled are clearly represented in the attached PTA Calculation.

The relevant dates where the applicant is not in agreement with the PTO's determination are discussed in more detail below.

In accordance with §1.705(b)(2)(iv)(A), the circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704 are clearly represented in the attached PTA Calculation.

Applicants believe the 86 day reduction between the filing of a Notice of Appeal on February 3, 2010 and an RCE on April 30, 2010 under 35 USC 154(b)(1)(B)(ii) is not proper. 35 USC 154(b)(1)(B)(ii) provides that the guarantee of no more than 3-year pendency does not include "any time consumed by appellate review by the Board." 37 CFR 1.702(b)(4) contains parallel language. Although 37 CFR 1.703(b)(4) appears to implement these provision by counting the number of days "beginning on the date on which a notice of appeal to the Board . . . was filed," this rule over counts days, because the filing of a notice of appeal does not commence the time period of appellate review by the Board. To the contrary, as set forth in 37 CFR 41.35, jurisdiction does not pass to the Board until after all briefs and the examiner's answer have been issued, at which time the Technology Center transmits the file to the Board. Until then, there is no "appellate review by the Board," and the examiner maintains jurisdiction, for example, to reopen prosecution or issue a notice of allowance.

In this application, there was no appellate review by the Board; indeed, no Brief on Appeal was ever filed. The notice of appeal was filed to maintain pendency while the examiner considered Applicants' concurrently filed response, and an Advisory Action was issued 2/23/2010, after which Applicants filed an RCE on 4/30/2010. Thus, the 86 day period between the filing of a Notice of Appeal on February 3, 2010 and an RCE on April 30, 2010 was in no

way related to appellate review by the Board, and so 35 USC 154(b)(1)(B)(ii) does not justify excluding these days from the 3-year pendency calculation. 35 USC 154(b)(1)(B)(ii) plainly does not apply here. To the contrary, this section provides for patent term adjustment when issuance is delayed due to "appellate review by the Board . . . in a case in which the patent was issued under a decision in the review reversing an adverse determination of patentability." Because there was no appellate review, let alone a reversal of a rejection, this statute is inapplicable here.

Applicants therefore respectfully request that the patent be accorded 1,012 days PTA.

A credit card payment form in the amount of \$200.00 to cover the fee stated in 37 C.F.R. § 1.18(e) is enclosed for this request.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. § 1.705, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

However, because this PTA error is due to a Patent Office error in interpreting and applying the PTA statute, a refund of the fee is respectfully requested.

Respectfully submitted,

Date AUG 09 2011

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By 

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## Patent Term Adjustment Calculation System



Add a new event to this case

Docket Number: 084437-0173

Application Number: 10/542997

Patent Number: N/A

	Event Description	Event Date	Days from Filing	PTO Days	Applicant Days
Edit Delete	Priority Date	01/29/2003	-904		
Edit Delete	International Filing Date	01/28/2004	-540		
Edit Delete	National Stage Entry (All 371(c) & (f) Requirements Met)	07/21/2005	0		
	PCT National Stage Commencement Date	07/21/2005	0		
	14 month From Application date	09/21/2006	427		
Edit Delete	Restriction Requirement	05/21/2008	1,035	608	
	3 Year Period Starts	07/21/2008	1,096		
Edit Delete	Non-Final Office Action Letter Restarting Period for Response	07/23/2008	1,098		
Edit Delete	Non-Final Office Action Letter Restarting Period for Response	07/24/2008	1,099		
Edit Delete	Restriction Requirement Response Received at PTO	08/12/2008	1,118		
Edit Delete	Non-Final Office Action	11/13/2008	1,211		
	Non-Final Office Action + 3 months	02/13/2009	1,303		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	04/24/2009	1,373		70
Edit Delete	Final Office Action	08/05/2009	1,476		
Edit Delete	IDS Rcv'd at PTO - No Statement under 1.704(d)	10/08/2009	1,540		
	Final Office Action + 3 months	11/05/2009	1,568		
Edit Delete	Final Office Action Response Received at PTO	01/20/2010	1,644		
Edit Delete	Notice of Appeal Received at PTO	02/03/2010	1,658		90
	3 Year Period Stopped	04/29/2010	1,743	647	
Edit Delete	Request For Continued Examination (including amendment)	04/30/2010	1,744		
Edit Delete	Non-Final Office Action	07/22/2010	1,827		
	Non-Final Office Action + 3 months	10/22/2010	1,919		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	01/13/2011	2,002		83
Edit Delete	Notice of Allowance	03/03/2011	2,051		
Edit Delete	Issue Fee Paid	06/01/2011	2,141		
Edit Delete	Patent Grant Date	07/12/2011	2,182		

Totals: 1,255 243  
PTA: 1,012

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IP: 10.14.43.80

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